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#9/10-23-01

PATENT
Attorney Docket No. 0459-0495P

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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TC 1700

APPLICANTS: LUNDEN, Klaus A. et al. CONF: 8716
SERIAL NO.: 09/701,261 GROUP: 1731
FILED: February 27, 2001 EXAMINER: FORTUNA, J.
FOR: USE OF COLLOIDAL PRECIPITATED CALCIUM CARBONATE AS
A FILLER IN THE PREPARATION OF PAPER

RESPONSE TO NOTICE OF NON-COMPLIANT AMENDMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

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Sir:

The following is submitted in response to the Notice of Non-Compliant Amendment issued in connection with the above-identified application on September 13, 2001.

Applicants submit that the Notice is in error and should be withdrawn for the following reasons.

1. First of all, the Notice refers to an amendment filed on "2-27-01" and indicates that the amendment filed on that date is considered "non-compliant" because it does not include a marked up version of the amended claims. However, Applicants did not file any amendment on the date indicated in the Notice. On 2-21-01 Applicants filed an Information Disclosure Statement, and submitted a Declaration and Power of Attorney. But no amendment to the claims was filed on that date.

2. Applicants did file a Preliminary Amendment on 11-27-2000 together with the other papers for filing of this new application. But if this is the amendment referred to in the Notice, the amendment was filed before the new rules went into effect on March 1, 2001. In fact, even the date of 2-27-01 indicated in the Notice is prior to the implementation date of March 1, 2001 of the new rules requiring a marked up version of amended claims. Thus, there could be no failure to comply with the new amendment procedures.

3. Finally, assuming that the Preliminary Amendment filed on November 27, 2000 is the amendment at issue, this amendment fully complies with the new procedures. Under the new procedures effective on March 1, 2001, an amendment to the specification or claims must include a marked-up version. But in the present case, all of the original claims 1-23 were canceled and substituted with new claims 24-44. In this kind of situation, where all of the old claims are canceled and substituted by a new set of claims, there is no need and there is no manner for submitting the marked-up version.

Perhaps there is some confusion with regard to claims 24 and 25 because of the nature of this case being a national stage of a PCT application. The published PCT application included claims 1-25, but those claims were replaced during international preliminary examination by new claims 1-23. Therefore, in the Preliminary Amendment Applicants properly canceled claims 1-23 since those were the claims existing in the international application at the time of filing the national stage case.

In view of the above, Applicants submit that the Notice of Non-Compliance issued on September 13, 2001 was issued in error and should be withdrawn.

Favorable action on this request and substantive action on the claims are requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

I hereby certify that this correspondence is being deposited with the United States Postal Service by first class mail, postage prepaid, in an envelope to the Commissioner of Patents and Trademarks, Washington.

D.C. 20231 on: October 15, 2001
(Date of deposit)

BIRCH, STEWART, KOLASCH & BIRCH, LLP

Jon M. Sillman
(Signature)
October 15, 2001
(Date of Signature)

LRS/lmt

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

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